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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,447	09/13/2000	Helen B. McIntosh	T2739-906589	7855
181	7590	03/04/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,447

Applicant(s)

MCINTOSH, HELEN B. 

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-31 and 38-46 is/are pending in the application.
4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 38-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>022305</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Please disregard the Non-Final Office Action sent on 1/25/2005 as it was sent in error. The PTO apologizes for any inconvenience this has caused. A corrected Office Action in response to applicants amendment of November 30th, 2004 appears to below.

Election/Restrictions

This application contains claims 28-31 drawn to an invention nonelected without traverse in Election/Restriction Response dated 11/10/2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendment

The affidavit filed under 37 CFR 1.132 filed November 30th, 2004 is insufficient to overcome the rejection of claims 38-46 based upon the rejection as set forth in the below Office action because: The materials submitted with the affidavit appear to be a compilation of various articles, letters, advertisements and applicants dissertation attempting to show long felt need and commercial success. However, applicants invention appears to be a method of using a rug (known in the art), a container for holding a rug (known in the art) and a set of instructions for their use (also known in the art), thus it is not the rug, container and instructions that are the actual invention but rather the method of use therefor. Since the applicants current claims are directed to a

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product anticipated or obviated by prior art, as stated below, it is the position of the examiner that based on the totality of the evidence the affidavit fails to overcome the prior art of record in terms of patentability. Furthermore, applicants have not provided any type of nexus between their claimed product and its purported commercial success. There is no evidence provided that the sales of applicant's product have out performed the sales of similar products on the market or that the claimed features as recited by the applicants are the reasons for the success or the amount of money spent on advertising vs. products of a similar nature or any other evidence which would be needed in order to consider commercial success for patentability.

Claim Objections

Claim 40 is objected to because of the following informalities: The phrase "multi-phase" should be "multi-phrase". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 42 and 43, it is not clear what features of the article applicants are attempting to claim. The claims appear to be method steps used in practice with the

claimed article but lack any structural or functional features which further limit the parent claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erumsele '631 in view of Joyce '000. Erumsele discloses an article of manufacture containing most of the elements of the claims including, a rectangular rug which is lightweight and portable (figure 1, rug 2 described at col. 2, lines 14-18 and lines 22-23) as required by claims 38 and 44, a temporary container for holding a rolled rug and other items (figure 2, elements 9 and 10) as required by claims 38 and 44. Regarding claims 39 and 45, lacking any further distinguishing features a top face pattern in quiet tones supportive of a conflict resolution process is considered to be embodied in Erumsele as shown in figure 1 and described at col. 2, lines 8-10. A rug being rolled in a roll is shown in figure 2 and is described at col. 2, lines 22-23.

Erumsele fails to explicitly disclose a script means as required by claims 38 and 44 with specific phrases as required by claims 40-41, 44 and 46 (**note**: applicants specification at pages 13-14 discloses a script means as a set of instructions (4)) and a rug having dimensions of at least about 2 feet by 3 feet as required by claim 39 and a

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rug having dimensions of about 3 feet by 5 feet as required by claim 45. Joyce discloses a game, which teaches that it is known to provide game amusement devices with a set of instructions (80) for the purpose of setting forth the rules of the game (Joyce, col. 5, lines 60-61). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided instructions with the article of Erumsele for setting forth the rules of the game. Furthermore it should be noted that it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. script text) and the substrate (e.g. instructions 4) which is required for patentability.

Regarding the specific rug dimensions as required by claims 39 and 45, it would have been obvious to manufacture the rug game board of Erumsele with dimensions of at least 2 feet by 3 feet or about 3 feet by 5 feet for the purpose providing a good mix of size, portability and storability, especially since Erumsele clearly states at col. 4, lines 6-9 that her rug may be any dimension in length and wide enough such that players may pass each other without interference both of which would be encompassed by the above dimensional limitations of claims 39 and 45 and since Erumsele is clearly

concerned with portability and storability of her game. Furthermore, the specific size of the rug is considered to be a design choice in that applicants clearly state that at page 6, lines 20-21 that the rug may be made of any shape, size and material suitable for carrying and handling.

Regarding claims 42-43, as best understood, lacking any distinguishing limitations Erumsele embodies claims 42 and 43 since any of those steps can be practiced with the game of Erumsele.

Response to Arguments

Applicant's arguments with respect to claims 38-46 have been considered but are moot in view of the new ground(s) of rejection. However, in order to make the record clear it should be noted that applicants current claims are essentially directed to a kit or system having several parts (e.g. rug, container and instructions/script) with a function of facilitating conflict resolution. Erumsele '631 clearly discloses a game that has a rug and a container, a set of instructions would have been clearly obvious to one having ordinary skill in the art as games. The courts have recently held that a kit which differs from prior art in a manner of use as demonstrated by a set of instructions is NOT patentable in a product type claim and should rather be directed to a method patent. *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. Furthermore it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case the game of Erumsele is clearly capable of functioning as a system for conflict resolution since two members playing a game can easily overcome their differences. Therefore it is the position of the examiner that Erumsele obviates applicants current claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

A handwritten signature in black ink, appearing to be 'JH' followed by a long horizontal stroke.

JESSICA HARRISON
PRIMARY EXAMINER